

The claims were amended to more clearly recite subject matter in the technological and useful arts. Specifically, the bodies of the claims now more clearly include recitation of the use of a “communications network.” Consequently, no basis exists to reject the claims under §101.

The specification was amended to address the objections concerning hyperlinks within the specification.

Claim 1 is amended to address the §112 rejection in the Office Action.

Art Rejections

Initial Matters

As an initial matter and for the sake of a clear record, not all of the claims that should have been analyzed were, and for some of the claims that were considered, not all of their limitations were properly analyzed. Consequently, applicants should not receive a Final Rejection in response to this Reply, as some original claims have not yet been examined.

For example, the Office Action provides no analysis of original independent claim 4 even though it had materially different claim limitations and scope than claim 1. Original claim 4 recites aspects directed to time stamping the receipt of competition tasks and the analysis of timing information. The Office Action is devoid of any analysis of these features and it is unclear why claim 4 (and its dependents 5-6) was rejected.

Likewise, the Office Action provided no analysis for independent claims 17 and 18, even though they had materially different claim limitations and scope than claim 1. Claim 17 for example is directed to a skilled based competition in which contestant responses are analyzed to create a specific user profile. Claim 18 is directed to a scoring technique in which a signature indicates the contestants’ responses. The Office Action is devoid of any analysis of these features and it is entirely unclear why these claims were rejected.

Moreover, (previously) multiply dependent claims 8-16 were erroneously not considered on the merits. The original claims (erroneously) used the conjunctive “and” instead of the disjunctive “or.” However, this form of claiming error is minor, and MPEP §608.01(n) makes clear that claims having such specific form of error be considered (contrary to the position stated in the Office Action). MPEP §608.01(n), in fact, only allows multiple dependent claims to be not considered on the merits when (a) they depend from another multiple dependent claim (see MPEP 600-71) or (b) they “cannot be understood” (see MPEP 600-73). In fact, the MPEP states that the claims should be considered on the merits and “no objection as to form need be made” when the dependency is clear. Id.

Substance of Rejection and Arguments in Response

Original claims 1-7 were rejected as unpatentable in view of an article about NetPlay and in view of the World Series. In short, the Office Action asserted that the NetPlay article taught most of the recited aspects of original claim 1 and that the World Series taught the regrouping of winners in a tournament to obtain an ultimate winner.

The Office Action asserted without support that it would have been obvious to modify NetPlay’s teachings to include the repeated monitoring of winners until there is a unique winner. Moreover, several of the assertions in the Office Action were incorrect. For example, the Office Action’s stated that the NetPlay article discloses a unique winner through disclosure of an “ultimate star” (see Office Action at p.4). This statement is incorrect. The NetPlay article never makes reference to an “ultimate star” and instead makes reference to a “star member.” More importantly, the NetPlay article is explicit that a “star member” is a service level one may purchase for \$19.99, not a unique winner status.

Moreover, the Office Action suffers a fundamental flaw of hindsight analysis. Specifically, the Office Action refers to no evidentiary support for the purported modifications,

and as outlined in more detail below provides no showing of even a suggestion (let alone a teaching) for the type of contest recited in the claims.

Amended claim 1 recites a method that allows a communication network to be used so that a large multitude of contestants may compete, resulting in a unique winner in a fixed, relatively short amount of time. (Support for the limitations that are directed to the large multitude of contestants and simultaneous play is found in the title of the application itself and at pages 7-9, 17, and 20 of the specification. Support for the limitations directed to the start and end times is found at pages 4, 7-8, and 10.)

As explained throughout the specification (indeed it's in the title of the application), the method concerns a skilled-based contest for a large multitude of simultaneous contestants in a given, single skill-based contest. The specification, for example, explains that exemplary methods allow on the order of millions of contestants to compete in a given, single contest and, at other points, states that the method allows "massive amounts of participants" (see page 17). (Of course, the actual number of contestants who actually compete in real life depends on the contestants themselves.) The phrase "large multitude" on its own, and also in view of the specification, has clear meaning in the relevant art and generally refers to games having an extraordinary number of contestants. For example, today, people in the art use the term Massive Multiplayer Online Game (MMOG) to refer to games having a huge number of players (see attached sheet E, entitled "What are Massive Multiplayer Online Games?" from website www.zona.net.) (Applicants do not know whether any of the games mentioned in the article properly constitute prior art but nonetheless distinguish such known MMOGs below.)

In contrast, the Office Action cites no games involving a large multitude of simultaneous contestants, and provides no art suggesting such. The NetPlay article refers to internet-based

versions of games such as Poker and Crazy 8s, which are each known to have relatively few contestants per contest. Likewise the World Series involves very few teams.

Indeed, Applicants provide herewith Attachment F which is a more recent description of the NetPlay game, cited in the Office Action.

Encircled in red in the upper right corner of page 1 is a statement "Play these games with up to six people!" This statement clearly shows an upper limit of six contestants and moreover the use of an exclamation mark indicates emphasis for such an upper limit. Clearly an upper limit of six people is a far cry from the present invention.

The Office Action cites no teaching or suggestion as to how the cited art might be modified to allow a large multitude of users, and provides no support for the proposition that having such games modified for a large multitude of users would be desirable or obvious.

Indeed the facts are opposite. For example, a sequentially played game (such as poker) would require in excess of 16 hours per card play with 6,000 contestants each having 10 seconds per card play. In addition, a large multitude of players clearly could not be supported by a single deck of cards, and combining decks of cards would introduce statistical probabilities of illegal card combinations and the like.

Moreover, amended claim 1 recites a method that supports a skilled-based contest in which a large multitude of contestants begin at a fixed start time and the game converges to a unique winner a short time thereafter. The specification for example explains that exemplary games end in about an hour, even if supporting about a million contestants. As explained in the specification, such a format helps create the excitement for players, advertisers and sponsors.

In contrast, the Office Action cites no games supporting a large multitude of users and having fixed start times and ending shortly thereafter. Indeed as explained above, sequentially

played games have end times that are linearly related to the number of contestants and thus will have enormous play times if enormous numbers of contestants are involved.

Moreover, known MMOGs such as EverQuest do not change the situation. These games are not real skill-based contests, but instead are role-playing games (see attached sheet E, entitled "What are Massive Multiplayer Online Games?" from website www.zona.net). They do not have fixed start times and do not end with a unique winner in a reasonably short time. Instead, players come and go as they please (meaning they are not truly simultaneous) in simulations that last weeks or months. Id. They are akin to the interactions described in the Background section of the specification at page 4.

Objective evidence shows that the recited game has consistently been treated as inventive, novel and not obvious, and applicants are aware of no evidence to the contrary. Moreover, applicants have provided herewith two Rule 132 declarations supporting such views from independent experts, each offering a unique perspective (one from a game expert, and another from an Internet expert).

For example, Attachments G-H are unsolicited statements from the media describing the *Live Trivia* game that embodied the invention. It should go without saying that the News media tries to devote attention to novel, newsworthy events. They do not try to report on old or obvious events.

Attachment G is a Wall Street Journal (WSJ) article devoted to *Live Trivia* game that embodied the invention. It was published soon after the game began to be played publicly. (See "Internet Quiz Show Intends to Transform Interactive TV, by William Bulkeley, WSJ.com, June 26, 2000, attached.) The article was written by William Buckley who is a WSJ staff writer who has written about innovations on the Internet and contributes to WSJ's technology column,

“Digits. Gambits & Gadgets in the World of Technology.” After referring to the then-popular TV show “Who Wants to Be a Millionaire”, the Bulkeley article stated: “Now, imagine the same game with 20,000 contestants.” (Emphasis added.) The Bulkeley article’s word choice – specifically that the readers would need to imagine -- clearly shows that the news media considered the game to be truly unique.

Likewise, Attachment H is an article by Heath Waldrop for his column “Technical Knockout” and it’s about the *Live Trivia* game that embodied the invention. He states, in connection with describing the game, that the interactivity was fun “and a novel idea.”

In addition, the company was featured on *Good Morning America*, *CNN*, and *MSNBC* in connection with the *Live Trivia* game that embodied the invention. The Associated Press reported on the game and it was picked up in newspapers around the country. Many other articles reported on the game (see, e.g., Attachments I-K).

All these unsolicited testimonials indicate that the game is novel and unique (this goes to the heart of being newsworthy, especially on this scale).

Attached herewith is a Declaration from Dr. Leszek Pawlowicz. As the declaration shows, Dr. Pawlowicz is an extremely well known game show contestant and has been analogized to be the “Michael Jordan” of game shows. In this regard, he is an expert at skill-based contests, and in his opinion the game and the invention are novel and non-obvious. As he describes, the invention’s support of an enormous number of simultaneous contestants in real time was unique and not obvious.

In addition, attached herewith is a Declaration from Dr. Ryan Nelson. Dr. Nelson is a Professor at the University of Virginia and is an expert on information systems, such as the Internet. He too refers to the invention’s ability to support a large volume of simultaneous

contestants as unique. Dr. Nelson is not being compensated for his time in connection with the Declaration.

Neither Dr. Pawlowicz or Dr. Nelson is aware of any art before the filing date of this application that suggests the invention is not novel or not obvious.

Moreover, the assignee received substantial investment primarily as a result of the excitement and novelty of the game, and has received significant licensing revenue to date as well. Consequently, the invention as recited in amended claim 1 should be found allowable. There is a vast body of objective evidence supporting this view and no known evidence to the contrary. Indeed, even the art relied on by the Patent Office suggests the contrary (see, e.g., Attachment F's reference to an upper limit of only 6).

Amended claim 4 recites another novel and non-obvious aspect of allowing a skill-based competition among a large multitude of contestants. More specifically, contestant nodes time stamp the receipt of a competition task and deliver timing information to a server node in conjunction with contestant responses. The server node analyzes the responses and the timing information to determine success and elapsed time such that the contestants' quickness may be determined independently of the relative performance of the network. Some of the attachments refer to this aspect, again, with laudatory terms. (Support for the changes to claim 4 is found at the same pages as outlined above with regard to the large multitude of contestants and at pages 23-5 for the timing limitations.)

As explained in the specification, the recited aspects allows the game to be played more fairly, by reducing the possibility of a contestant getting a technical advantage from a faster modem or link. Indeed, the initial public play of the game was won by a contestant using a relatively slow modem.

As outlined above, this claim was not analyzed in the Office Action. However, it is clear that none of the cited or known art even hints at the recited features.

Amended claims 8-16 recite several novel and non-obvious features, related to the creation and use of various forms of contestant profiles, click-on coupons, and branded questions. These claims were amended to correct informalities and to recast them as dependent on claim 1. The subject matter should have been, but was not, considered in the Office Action. The recited features are not taught or suggested by the cited art.

Amended claim 17 is directed to a skill-based contest for a large multitude of users and in which profile information about user preference, interests, or contestant competition task performance is created by analysis of contestant responses. The subject matter should have been, but was not, considered in the Office Action. The recited features are not taught or suggested by the cited art.

Amended claim 18 is directed to a skill-based contest for a large multitude of users and in which a unique signature for each contestant is created that is indicative of at least some of the contestant's responses to competition tasks. The subject matter should have been, but was not, considered in the Office Action. The recited features are not taught or suggested by the cited art.

In view of the arguments set forth above, Applicant respectfully submits that the rejections contained in the final Office Action, have been overcome, and that the claims are in condition for allowance. If the Examiner believes that any further discussion of this communication would be helpful, please contact the undersigned at the telephone number provided below.

Applicant encloses herewith a Petition for a Three Month Extension of Time pursuant to 37 C.F.R. § 1.136, to respond to the Examiner's Office Action. Our deposit account no. 08-0219 is to be charged the \$465.00 fee for this purpose.

Applicant also encloses herewith a Notice of Appeal. Please charge Deposit Account No. 08-0219 the \$160.00 fee for this submission.

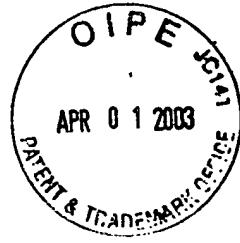
Please charge any underpayments or credit any overpayments to Deposit Account No. 08-0219.

Respectfully submitted,



Peter M. Dichiara
Reg. No. 38,005
Attorney for Applicant

Hale and Dorr LLP
60 State Street
Boston, MA 02109
(617) 526-6466
March 25, 2003
Attorney Docket No.: 109779.135



Attachment A (Marked-Up Version)

two inefficiencies combined relegate the average person to participating vicariously by watching taped versions of games played days in advance.

In addition to traditional game shows, multi-player video-based games exist.

Multi-player video-based games such as UltimalOnline (www.UltimalOnline.com) allow multiple people to engage in an electronic game at one time. This provides additional value to consumers who would like to participate in a game with multiple people.

Additionally, becoming a participant in the game takes little time since it can be accessed from a connection to the Internet. However, participants must pay to play the game.

Further, these games do not satisfy the general requirements of competitive skill-based games such as game shows which have (1) a winner and (2) a defined start and end time. These games are ongoing interactions that allow participants to take turns in order to simulate interactions though they are not actually playing simultaneously.

A number of games have arisen on the Internet that simulate game shows broadcast over television. For instance, Sony has a number of games that can be played over the Internet which simulate traditional game shows. Jeopardy! Online or Trivial Pursuit Online (www.station.sony.com) are Internet games that allow multiple players to come together to simulate the traditional versions of these games. This allows individuals who would like to feel the competitive nature of these games to enjoy them online. However, four key elements are missing from the value proposition: (1) the games simply pool a limited number of individuals into a simulated game as the players arrive at the site and (thus, one cannot really compete against the larger public), (2) the

RECEIVED

APR 03 2003

GROUP 3600



Attachment C (Marked-Up Version)

Please amend the claims as follows. For the Examiner's convenience, all pending claims are shown below in marked-up form. Unamended claims are shown in small font.

1. (Amended) A method of using [an electronic] a communication network so that [multiple] a large multitude of users may simultaneously [can] compete in a skill-based contest as contestants, comprising:
 - a. identifying [a set] a large multitude of contestants;
 - b. grouping the [set of] contestants into group subsets according to group criteria;
 - c. matching contestants within the [a] group subsets into subcompetitions;
 - d. for each subcompetition, [electronically] presenting a competition task over the communication network to the contestants of the subcompetitions;
 - e. monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition;
 - f. grouping at least some of the contestants according to at least one of the group criteria or subcompetition outcome status;
 - g. repeating acts (c)-(f) until there is a unique winner of the contest wherein the contest begins for all contestants at a fixed start time and converges to the unique winner in a fixed, short amount of time after the fixed start time.

RECEIVED
APR 03 2003
GROUP 3600

2. The method of claim 1 wherein the subcompetition outcome status includes at least the states win, lose, and tie.
3. The method of claim 1 wherein the subcompetition tasks are presented in act (d) substantially simultaneously.
4. (Amended) [A method of using an electronic network so that multiple users can compete in a skill-based contest comprising:

- a. identifying a set of contestants distributed over the electronic network;
- b. electronically delivering a competition task to contestant electronic nodes;]

The method of claim 1 wherein the competition task is delivered from a server node to contestant electronic nodes and wherein the method further comprises

[c.] contestant [electronic] nodes timestamping the receipt of the competition task, and delivering timing information to a server node in conjunction with contestant responses to the competition task;

[d.] the server node analyzing the contestant responses and timing information and determining therefrom competition task successes and elapsed time of successes so that the server node may determine the quickness of contestants independently of the performance of the communication network relative to the contestant nodes.

5. The method of claim 4 wherein the competition tasks are presented substantially simultaneously.

6. The method of claim 5 wherein the server node enforces a time deadline for the receipt of response.

7. (Amended) [A method of using an electronic network so that multiple users can compete in a skill-based contest, comprising:

- a. identifying a set of contestants distributed over the electronic network;
- b. multicast delivering a competition task to contestant electronic nodes substantially simultaneously, so that each contestant competes simultaneously with other contestants;
- c.] The method of claim 1 wherein contestants [responding] respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid.

8. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to create contestant profile information.

9. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

10. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile demographic information.

11. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein contestant response information is recorded to compile psychographic information.

12. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and wherein prizes are awarded to contestants.

13. (Amended) [The methods of claim 12] The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant response as valid and and wherein prizes are awarded to contestants and wherein the prizes include click-on electronic coupons.

14. (Amended) [The method of claim 13] The method of claim 1 wherein contestants respond to the competition task within a certain time established by contest rules and enforced by a server node, for the server node to consider the contestant

response as valid and wherein prizes are awarded to contestants and wherein the prizes
include click-on electronic coupons and wherein user activation of a click-on electronic
[coupons] coupon is user response information.

15. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein
contestants respond to the competition task within a certain time established by contest
rules and enforced by a server node, for the server node to consider the contestant
response as valid and wherein the competition tasks include branded questions.

16. (Amended) The [methods] method of [claims] claim 1[, 4, and 7] wherein
contestants respond to the competition task within a certain time established by contest
rules and enforced by a server node, for the server node to consider the contestant
response as valid and wherein the contests awards points to users based upon their
responses, and these points are redeemable for prizes.

17. (Amended) A method of using [an electronic] a communication network so that
[multiple] a large multitude of users may simultaneously [can] compete in a skill-based
contest as contestants, comprising:

- a. presenting competition tasks to contestants;
- b. collecting responses to the competition tasks from the contestants;
- c. analyze the responses to create user profile information about user preference,
interests, or contestant competition task performance.

18. (Amended) A method of using [an electronic] a communication network so that [multiple] a large multitude of users may simultaneously [can] compete in a skill-based contest as contestants, comprising:

- a. presenting competition tasks to contestants;
- b. analyzing contestant responses;
- c. creating a unique signature for each contestant indicative of at least some of the contestant's response.